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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

D'AGOSTINO, PAUL ANTHONY

ART UNIT	PAPER NUMBER
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3714

MAIL DATE	DELIVERY MODE
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08/17/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/599,801

Applicant(s)

COURSE, ANTONY

Examiner

Paul A. D'Agostino

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/CD)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This responds to Applicant's Arguments/Remarks filed 07/29/2010. Claims 18 and 23-24 have been amended. Claims 1-17 stand cancelled. Claims 18-32 are now pending in this application.

Response to Amendment

1. Examiner appreciates the effort Applicant made to adopt suggestions to advance prosecution. However, Applicant's approach to resolving the 112, sixth paragraph rejection, to cancel the claim language has raised some new rejections. Those are presented here for Applicant's consideration. Further, because the claims are now broader, the rejection under 103 is maintained.
2. Applicant has cured the minor formality dealing with the use of trademarks in the Specification. The objection to the Specification is withdrawn.
3. Applicant has amended Claims 23-24 to remove minor informalities. The objection to the claims is withdrawn.
4. Applicant has amended Claim 18 removing the means plus function language invoking 35 U.S.C. § 112, sixth paragraph. The rejection of claims 18-32 is withdrawn.
5. Applicant has amended the claims to recite "not including a data inputting joystick for data that would otherwise be inputted into said pre-existing computerized game via a joystick" which overcomes the art of record as the claims are best understood. Thus, the rejection of the claims under 35 U.S.C. §103 is withdrawn.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 18-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

a) Support cannot be located in the Specification for pre-existing games. An instance of existing game content can be found but not for pre-existing game content (Page 6 Line 24).

b) Support cannot be located for use of the claimed invention with non-ball games as recited in the preamble and in the body of Claim 18. The scope of the disclosure is for ball games (Title and "The game is built to be used for any ball game" Specification Page 6).

c) Support cannot be located but for a litany of references to software and software functionality that without the particulars of what is the means by which the data is inputted into a pre-existing game for player interaction that it is unclear whether or not Applicant was in possession of the subject matter of the claimed invention with sufficient specificity to one of skill in the art.

Appropriate attention is required.

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 18-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. From the disclosure, it cannot be ascertained what is meant by "pre-existing" in the preamble and in the body of the claims such that the scope of the claims can be ascertained. The current game being player is pre-existing. Commercial and non-commercial games are pre-existing. Ball and non-ball games are pre-existing. Each new level in a game is pre-existing. But the disclosure doesn't address all these aspects and so the limitation fails to help understand the meters and bounds of the claimed invention.

b. The claimed invention as amended can modify any game with a ball game – a recitation so vague and indefinite as to what this actually means that the scope of the claims cannot be determined.

c. Applicant has amended the claims for 112, sixth paragraph purposes, the claims and the disclosure still present a litany of references to software and software functionality but fail to describe the invention such that the invention is clearly understood by one of skill in the art.

Specifically, the amended claims recite "thereby inputting data into said pre-existing game". Applicant's Specification discloses that ball trajectories "can be calculated by a computer device which is programmed to know ..." (Page 4 Lines 10-

11)... "From these calculations software provides information about the characteristics of the movement of the ball" (Page 4 Lines 23-24); and "The interactive ball game software ..." (Page 6 Lines 21); Each of the sensors are connected to a control box which has software" (Page 9 Line 15); "It is preferred that the signals operate in synchronization and this can also be controlled by the computer program" (Page 9 Line 19); "The actual variations can enable the software program which is located in the control box ..." (Page 10 Line 5); "The control box can ... calculate the speed and path ..." (Page 10 Lines 9-10); and "The output can be fed directly to an Internet site ..." (Page 10 Line 13). For all of the above references point to software and what is can so but fail to support the claims such that the scope of the claims can be best understood.

As indicated in the last office action there is a) no support for the particulars of the software for processing the signals in combination with the "control box" ; and b) no disclosure is made of the software or algorithms used to logically process the signals or match the ball trajectory data to an appropriate existing game graphic to create images responsive to the player's interaction. Thus, without importing limitations from the Specification into the claims, the Specification makes vague references to what software will so to create the game but never disclosing what it is that is being done.

10. Claims 18-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. From the disclosure and the original claims it has not been taught or

described without incurring undue experimentation how the data from an input device of a ball being tracked by sensors providing signals to a control box with software can "thereby input{ting} data to said pre-existing computerized game". Further, it is unknown how the capture of ball trajectory data is supposed to operate games that would have required a joystick. For example, a joystick interpreted reasonably broadly typically has multiple firing buttons, can be one-handed or two-handed, can be a rocker or thumbpad or left and right thumbpads on a controller, etc., the combination of controls on the joystick capable of multi-input modes of signal generation. The claims as amended recite that Applicant's claimed invention replicates what a game console can do for any computerized game. Such a disclosure has not been provided other than a series of abstract statements such that it would require undue experimentation to enable one to readily replace their joystick for any game with Applicant's claimed invention. Appropriate attention is required.

Response to Arguments

11. Applicant's arguments, see Applicant's Arguments/Remarks pages 9-11, filed 7/29/2010, with respect to the rejection(s) of claim(s) 18-32 under 35 U.S.C. § 103(a) have been fully considered and are persuasive as the fact that the combination of prior art used by Examiner does not provide input to a device otherwise configured to receive input via joystick. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection precipitated by Applicant's amendments is made in view of 35 U.S.C. § 112 for new matter, enablement, and written description.

The key questions that need to be resolved are what is meant by a pre-existing game? Examiner finds Applicant's argument unpersuasive in that pre-existing game is a broad term encompassing many variations. How is all the data collected and manipulated in the control box by the software? How can an interactive ball input be integrated with non-ball games? What are the actual software particulars? Not just generalizations that enables one to replace a game console joystick with a ball tossing input interface and how is the actual pre-existing game, if not the game being played, representing that data to conduct the game in lieu of a conventional joystick?

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

13. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. D'Agostino whose telephone number is (571)270-1992. The examiner can normally be reached on Monday - Friday, 7:30 a.m. - 5:00 p.m..

14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dmitry Suhol can be reached on (571) 272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Paul A. D'Agostino/
Examiner, Art Unit 3714

/John M Hotaling II/
Primary Examiner, Art Unit 3714